REMARKS

At the time of the Office Action dated May 20, 2005, claims 1-20 were pending and rejected in this application.

CLAIMS 1-20 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON SUSARIA ET AL., U.S. PATENT APPLICATION PUBLICATION NO. 2004/0015936 (HEREINAFTER SUSARIA), IN VIEW OF BRACHA ET AL., U.S. PATENT NO. 6,601,114 (HEREINAFTER BRACHA)

On pages 3-11 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Susaria in view of Bracha to arrive at the claimed invention. This rejection is respectfully traversed.

Independent Claim 1

The Examiner asserted on page 4 of the Office Action that:

> Susaria failed to specify a list of peer class loaders. However, a hierarchical stack of class loaders is a data structure linking related elements, with a similar effect to 'listing peer class loaders'. Peer class loader can be identified, as they have a common parent node in the hierarchical data structure.

At the outset, Applicants note that a rejection under 35 U.S.C. § 103 requires that the applied prior art, either alone or in combination, teach or suggest all the claimed features. Applicants are unaware of any case law that allows a claimed feature to be considered taught or suggested by a disclosed feature because the disclosed feature "[has] a similar effect to" the claimed feature. Referring to M.P.E.P. § 2144.06, even if the two features could be considered functional equivalents, for one having ordinary skill in the art to consider the substitution of one for the another as being obvious "the equivalency must be recognized in the prior art" (emphasis added).

2

The Examiner, however, has neither factually established that these features are equivalent nor

factually established that such an equivalency is recognized by the prior art.

Claim 1 recites that the "list of peer class loaders <u>arranged in accordance with the</u>

<u>associated dependency specification</u>," and on page 13 of the Office Action, the Examiner

asserted that "the hierarchical ranking is in accordance with the associated dependency

specification" and "[t]he 'dirty monitor' has logic to alter the hierarchical order when a class has

been modified" and cited paragraphs [0105]-[0108] of Susaria for support. Upon reviewing both

Susaria, as a whole, and the Examiner's citation, Applicants are unable to locate such a teaching.

Thus, the Examiner has failed to establish where this limitation is either taught or suggested by

the applied prior art.

The Examiner further asserted on page 4 of the Office Action the following:

> Susaria failed to specify "list generation logic", generated when said specific class structure has
> been replaced or when said dependency specification has been modified. Although Susaria failed
> to generate a "list", he did disclose that when a class was replaced/ modified, that dependent
> classes are provided with appropriate class loaders. The hierarchical tree relates to dependencies.

By the Examiner's own admission, Susaria fails to teach or suggest the claimed "list generation

logic" or that Susaria generated a "list." Furthermore, the Examiner failed to establish a

motivation for modifying Susaria to arrive at the claimed invention.

Moreover, since the Examiner admits that Susaria fails to teach or suggest the claimed

list, the Examiner must also admit that the Susaria cannot teach when the list is created (i.e.,

"when said specified class has been replaced or when the said dependency specification has been

modified") Thus, notwithstanding the other claimed features that the combination of Susaria and

Bracha fail to teach or suggest, based upon either of these two features alone (i.e., the list and the

list generation logic), the Examiner has failed to establish a prima facie case of obviousness.

The Examiner's statement on page 12 that "both are data structures, linking children

(peers) to a parent loader" suffers from a failure in logic. The claimed invention recites "peer

class loaders" (emphasis added), yet the Examiner has improperly asserted that this feature is

disclosed by linking children to a parent loader. The plain meaning of the word "peer" is

equivalent (in some respect), which is very different from parent/child which implies differences.

Applicants also note the statement by the Examiner on page 4 of the Office Action that:

It is inherent that a 'dirty class monitor' provides some type of indication (flag) when a 'dirty'
condition exists. (emphasis added)

The Examiner has again confused the difference between a claimed feature and a disclosed

feature having comparable advantages and/or functions with the requirement that the claimed

feature be taught or suggested by the applied prior art.

Furthermore, Applicants submit that the Examiner's reliance on the doctrine of inherency

is misplaced. Inherency may not be established by probabilities or possibilities. The mere fact

that a certain thing may result from a given set of circumstances is not sufficient to establish

inherency.[1] To establish inherency, the extrinsic evidence must make clear that the missing

---

[1] In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency
was based on what would result due to optimization of conditions, not what was necessarily present in the prior art);
In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

4

element must <u>necessarily be present</u> in the thing described in the reference, and that the necessity

of the feature's presence would be so recognized by persons of ordinary skill.[2] Furthermore, as

articulated by the Honorable Board of Patent Appeals and Interferences in <u>ex parte Schricker</u>, 56

USPQ2d 1723, 1725 (BPAI 2000):

> However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. <u>Compare,</u> <u>In re Rijckaert</u>, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art); <u>In re Yates</u>, 663 F.2d 1054, 107, 211 USPQ 1149, 1151 (CCPA 1981).

The Examiner did not discharge that burden of indicating where such a teaching or suggestion

appears in the prior art. Thus, the Examiner has not established that the claimed "flag indicating

whether said class has been replaced" is inherently disclosed by the applied prior art. In this

regard, the Examiner is also referred to M.P.E.P. § 2112, entitled "Requirements of Rejection

Based on Inherency; Burden of Proof."

  With regard to the Examiner's secondary reference of Bracha, the Examiner asserted on

page 5 of the Office Action, the following:

> Susaria disclosed dynamic class loading, but failed to explicitly specify "deference logic configured to defer". However, Bracha disclosed (FIG. 4 & Col. 11, lines 40-46), "In lazy loading ... a class is not loaded until it is needed during execution (deference logic)." Col. 15, lines 9-11, "The constraints written or otherwise recorded for use by the VM ... are enforced, e.g., checked, when and if referenced class B is actually loaded." col. 15, lines 29-31, "... a VM can implement fully lazy loading with verification."

Although not entirely clear from the Examiner's comments, it appears the Examiner is asserting

that Bracha discloses the claimed deference logic. Although Bracha discloses that "a class is not

loaded until it is needed during execution" (column 11, lines 40-41), this teaching fails to

---

[2] <u>Finnegan Corp. v. ITC</u>, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); <u>In re Robertson</u>, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); <u>Continental Can Co. USA v. Monsanto Co.</u>, 20 USPQ 2d 1746 (Fed. Cir. 1991); <u>Ex parte Levy</u>, 17 USPQ2d 1461 (BPAI 1990).

disclose the claimed deference logic, which requires deferral of the <u>locating</u>, <u>defining</u>, and <u>loading</u> of specified class to the peer class loaders in the list. The Examiner's citation to Bracha discusses deferring loading a class, but <u>Bracha is silent</u> as to deferring the <u>locating</u> and <u>defining</u> of the class. The Examiner also discussed "verification" within Bracha, but this "verification" also appears to be silent with regard to the claimed deferring the locating and defining of the class loader (see column 10, line 62 though column 11, line 14 of Bracha for a detailed discussion of verification).

Moreover, the claimed deference logic states that the locating, defining, and loading is deferred <u>to the peer class loaders in the list</u>. The Examiner, however, failed to establish where Bracha teaches this limitation. Therefore, <u>even if</u> one having ordinary skill in the art were motivated to modify Susaria in view of Bracha, the claimed invention would not result since Bracha fails to teach the limitations (i.e., deferral logic, which is configured to defer locating, defining, and loading of the specified class to peer class loaders in the list) for which Bracha is being relied upon.

For the reasons stated above, Susaria and Bracha fail to teach or suggest many of the limitations for which these references are being relied upon by the Examiner. Thus, even if these references were combined, the claimed invention would not result. Thus, the Examiner has failed to establish a prima facie case of obviousness, and Applicants respectfully solicit withdrawal of the imposed rejection of claims 1-3 under 35 U.S.C. § 103 for obviousness based upon Susaria in view of Bracha.
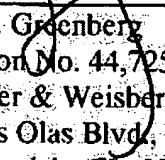
Independent Claim 4 and 12

Similar to claim 1, independent claims 4 and 12 include the concepts of (i) generating a list of peer class loaders in accordance with a dependency specification; and (ii) deferring the location, definition and loading of a specified class to peer class loaders in the list (comparable to the claimed deference logic). With regard to the first concept, as already noted during the discussion of claim 1, Susaria fails to teach this limitation. As to the second concept, the Examiner already admitted with regard to claim 1 that Susaria fails to teach or suggest the claimed deference logic, yet on page 7 of the Office Action, the Examiner asserted that Susaria discloses this feature. Since the Examiner has already admitted that Susaria fails to teach or suggest this limitation (see pages 5 and 14 of the Office Action) and, as discussed above, Bracha also fails to teach this limitation, the combination of Susaria and Bracha fails to teach the claimed invention as recited in claims 4 and 12. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 4-20 under 35 U.S.C. § 103 for obviousness based upon Susaria in view of Bracha.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is

hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to

such deposit account.

Date: August 22, 2005   Respectfully submitted,

                                                Steven M. Greenberg
                                                Registration No. 44,725
                                                Christopher & Weisberg, P.A.
                                                200 E. Las Olas Blvd, Suite 2040
                                                Fort Lauderdale, FL 33301
                                                Tel: (954) 828-1488
                                                Facsimile: (954) 828-9122